

GOBIERNO DE PUERTO RICO
DEPARTAMENTO DE ESTADO

January 25, 2023

Maria Teresa Szendrey Ramos
PO Box 364225
San Juan, PR 00936

SUBJECT MATTER
MARK

Office Action



CLASS
FILING NUMBER
FILING DATE
APPLICANT

032
248391-32-0
June 14, 2022
Alimentos Maravilla, S.A.

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- | | |
|--------------|--|
| <u> x </u> | 1. State clearly the goods or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services. |
| <u> x </u> | 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico. |
| <u> </u> | 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico. |
| <u> </u> | 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application. |
| <u> x </u> | 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation. |
| <u> </u> | 6. Others. |
| <u> </u> | 1. The registration for the applied mark is refused on the following grounds: |

OFFICE ACTION

The P.R. Trademark Office (the "P.R.T.O.") has reviewed its records and has determined that there are no similar or pending marks that would bar registration of this mark under the P.R. Trademark Act. However, in order to proceed with the examination of the mark, the P.R.T.O. requires the Applicant to amend the application as follows:

Description of Goods is Overly Broad:

Rule 20 of the Trademark Registry Procedure Code of the Department of State for The Commonwealth of Puerto Rico (hereinafter, the Rules) provides that applications for registration of trademarks must include a list of the goods or services in relation to which a Trademark registration is desired.

An application of a mark must specify the goods or services on or in connection with which the Applicant uses, the mark in commerce. The identification should set forth common names, using terminology that is generally understood. The identification of goods or services must be specific, definite, clear, accurate, and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), reversed on other grounds, 824 F.2d 957 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The wording: "Malt beverages." under International Class 032, contains language that isn't specific enough therefore, resulting in a broad description of the products.

The Registry has discretion to require the degree of specificity necessary to identify the goods or services in relation to which the mark is used in the commerce of Puerto Rico.

The applicant may adopt the following recitation of goods, if accurate:

Class 032

Non-alcoholic malt beverages.

* Note that these suggestions are illustrative and not exhaustive.

Applicant is advised to examine the International Classification of Goods and Services established under the Nice Agreement, Tenth Edition, to describe the products or services that are used commercially in Puerto Rico. See <http://www.wipo.int/classifications/nice/es/>.

Note that Rule 33 of the Rules provides that the applicant may amend his application during the review of the application, when required by the Examining Attorney or other official reasons. The applicant may amend his application to clarify or limit, but not to extend the identification of goods or services. Given the above, the Examining Attorney requires that the applicant modify and amend its application for renewal as indicated in this Office Action or otherwise show cause why this amendment is not necessary.

Disclaimer of Non-Registrable Components

A "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark, such as wording that is merely descriptive, generic or primarily geographically descriptive of the goods and/or services and is wording or an illustration that others would need to use to describe or show their goods and services in the marketplace. See Article 6 of the Puerto Rico Trademark Act of 2009, as amended. A disclaimer does *not* affect the appearance of the mark and it does *not* remove the disclaimed matter from the mark. See Article 6 of the Puerto Rico Trademark Act of 2009, as amended; *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965).

Applicant must disclaim the wording “**MALTA**” because it is merely descriptive of a feature, purpose, or use of applicant’s goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012).

The wording “**MALTA**” appears in applicant's goods/services identification. See application (“Malt beverages”). Therefore, the wording must be disclaimed.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. See Article 5 of the Puerto Rico Trademark Act of 2009, as amended; *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

If applicant does not provide the required disclaimer, the PRTTO may refuse to register the entire mark. See Article 6 of the Puerto Rico Trademark Act of 2009; *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use the word “MALTA” apart from the mark as shown.

DRAWING:

Rule 22 of the Rules of Procedure of the Trademark Registry of the Department of State of Puerto Rico of 2011 indicates that for every application, either with use or bona fide intent to use the mark in the Commerce, the Applicant shall submit a drawing of the mark as used or intends to use in trade. The drawing must not have a size larger than 8-1/2 "x 11". If Applicant submit a drawing of the mark by any electronic method, it must be in JPG, PDF or any other format, from time to time, the Register set as acceptable, and scanned at no less than 300 dots per inch (dpi) and no more than 350 dots per inch (dpi) with a length and width of not less than 250 pixels and no larger than 944 pixels. All lines must be clean, clear and solid, not fine or saturated, and will have to produce a high quality image to be reproduced.

A drawing must be provided if the Applicant wants to register a mark that includes a design of two or three dimensions, colored, and / or words, letters or numbers or a combination of these in a style of letter ("font"). The drawing must show the mark in a background ("background") black or white, unless you are claiming color as a component of the Mark. When claiming Brand color (s) as a component of the Mark, the drawing must depict the mark in color, and the Applicant shall identify (the) color (s), describe where shown (n) (the) Color (s) in the Mark, and claim that (the) color (s) is (are) a component of the Mark.

The applicant must submit a proper drawing with the Trademark Application. Submitting a facsimile and / or specimen showing the mark as used is not sufficient to show clearly the design that applicant wants to register. The purpose of the drawing is to provide notice of the nature of the mark to be registered. The drawing of the mark is entered in the PRTTO records and available to the public.

The application for registration included a pixelized and a blurry drawing that does not clearly demonstrate the design of the mark to be protected. Therefore, the

application must include a clear drawing of the mark to be registered.

In light of the aforementioned, the Examiner requires the Applicant to modify and/or amend the application for registration as provided herein or, otherwise, show cause why such modification is not required.

According to Rule 36 of Puerto Rico's Trademark Rules of Procedure amendments filed must be specified in a written and signed statement by the Applicant or its Representative. Neither Applicant nor its Representative shall rewrite, alter, modify, erase or include words in a pending application. However, the Puerto Rico Trademark Office (PRTTO) may amend the said application with the Applicant's consent.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety **(90) days**, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/> using the transaction office action response. The cost for the said filing is **\$15.00**. If you have any questions via email to jpagan@estado.pr.gov

Cordially,



Julio J. Pagán Pérez
Examining Attorney
Puerto Rico Trademark Office